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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/828,357

04/19/2004

Bill J. Peck

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AGILENT TECHNOLOGIES INC.

INTELLECTUAL PROPERTY ADMINISTRATION,LEGAL DEPT.

MS BLDG. E P.O. BOX 7599

LOVELAND, CO 80537

EXAMINER

FORMAN, BETTY J

ART UNIT

PAPER NUMBER

1634

NOTIFICATION DATE

DELIVERY MODE

04/01/2009

ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

IPOPS.LEGAL@agilent.com

**Advisory Action  
Before the Filing of an Appeal Brief**

**Application No.**

10/828,357

**Applicant(s)**

PECK ET AL.

**Examiner**

BJ Forman

**Art Unit**

1634

**--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

THE REPLY FILED 13 March 2009 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☐ The period for reply expires \_\_\_\_\_ months from the mailing date of the final rejection.  
b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.  
Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**NOTICE OF APPEAL**

2. ☐ The Notice of Appeal was filed on \_\_\_\_\_. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

**AMENDMENTS**

3. ☒ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because:  
a) ☒ They raise new issues that would require further consideration and/or search (see NOTE below);  
b) ☐ They raise the issue of new matter (see NOTE below);  
c) ☒ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or  
d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See Continuation Sheet (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).  
5. ☒ Applicant's reply has overcome the following rejection(s): 35 U.S.C. 103 over Webb in view of Blanchard.  
6. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).  
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☒ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.  
The status of the claim(s) is (or will be) as follows:  
Claim(s) allowed: \_\_\_\_\_  
Claim(s) objected to: \_\_\_\_\_  
Claim(s) rejected: 1-4, 8-19, 21-24 and 34-39  
Claim(s) withdrawn from consideration: 25-29, 32 and 33

**AFFIDAVIT OR OTHER EVIDENCE**

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).  
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).  
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

**REQUEST FOR RECONSIDERATION/OTHER**

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.  
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). \_\_\_\_\_  
13. ☐ Other: \_\_\_\_\_.

/BJ Forman/  
Primary Examiner, Art Unit 1634

## Continuation of 3. NOTE:

The amendments further define all methods of fabrication wherein at least 2 features of the array have different size. While the previously examined claims were not so limited. The amendment, if entered would not overcome the prior art of record because as cited in the Final Office Action, Hirota specifically teach arrays having features of differing size and provides motivation and/or reasoning for producing arrays having different sized features. The amendments further introduce the recitations from claims 34, 36 and 38 into the independent claims. These claims were previously rejection over the prior art and objected to for not further limiting the independent claim. It is maintained that the recitations of previous claims 34, 36, 38 are encompassed by the teaching of Blanchard and therefore do not simplify issues for appeal. For all the above reasons, the amendments are not entered.

Applicant's arguments have been reviewed but are not found persuasive to overcome the rejection under 35 U.S.C. 103 over Blanchard and Hirota. Applicant points to elements missing from each reference, and then concludes that because neither teaches all the elements, the combination does not make obvious the invention. First, Applicant asserts that Blanchard does not teach fabrication via a layout that has a feature size based on biopolymeric ligand. Then, Applicant further argues that Hirota does not teach a method of in situ fabrication. From this, Applicant asserts that a case of obviousness has not been made. It is maintained that the combination of Blanchard and Hirota teach all the elements of the examined claims. As stated in the office action, Blanchard specifically teaches in situ synthesis using a layout for array synthesis based on oligo specification file § 5.52. Furthermore, Hirota teaches features of differing size (Abstract) using waveform modulation as claimed. It is maintained that the cited art teaches all the elements of the invention. The rejections under U.S.C. 103 over Blanchard and Hirota are maintained for reasons of record.

Continuation of 11. does NOT place the application in condition for allowance because: Applicant's arguments regarding the Webb reference have been considered and are found persuasive. The rejections under 35 U.S.C. 103 over Webb in view of Blanchard are withdrawn.